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if to five significant figures of 1.0000:1.8750, which rounded to one significant figure is 1:2. Thus, it can be seen that the ratio 2:1, which was listed originally, was clearly in error, and the amended ratio 1:2 clearly correct. Also the corrected ratio was previously examined, and, as proper, no objection to it was made in the preceding Office action, Paper No. 6. In fact, it was stated in Paper No. 6 on page 3, in the second full paragraph, in accepting the 1:2 ratio limitation, as follows:

"[T]he ratio of restraining member to the base member can be seen to be about 1:2."

Again, in order for the Examiner to set forth a new objection over material that has been already approved, he should show at least a manifest mistake in the previous approval, and approval from a previous Examiner is highly persuasive. Compare, Grier, 1923 C.D. 27; Hay, 1909 C.D. 18; Nealon, 1897 C.D. 174. The standard is very high, and the Examiner has not met his burden.

The rejection of claims 18 and 19 under 35 USC 103(a) over Smeja et al., US 5471799, as set forth in Paper No. 8 is respectfully traversed. Smeja et al. nowhere teaches or suggests the present claimed invention, with its round base, to a person of ordinary skill in the art under the meaning of Section 103(a).

It is not enough to make out a prima facie case for the prior art to say that the base is preferably a square but could be other shapes. "Other shapes" is so ambiguous as to provide no motivation for any particular shape, save perhaps a rectangle. What other shapes are contemplated by the prior art? There must be a suggestion directing the person of ordinary skill in the art to a round base. It is well settled that the Examiner must point to an advantage clearly present in the prior art to motivate the ordinary artisan to make such a base. Note, In re Sernaker, 217 USPQ 1, 6 (Fed. Cir. 1983). He has not done so.

Among the errors found in Paper No. 8 are the following:

"It would have been an obvious matter of design choice to modify the base 12 to be round, since applicant has not disclosed that a round base solves any stated problem or is for any stated purpose.

"One of ordinary skill would be motivated to make such a modification so that the snow guard 10 could be installed at any orientation and still be effective."

Against the first misstatement, the Examiner's attention is directed to the present specification on page 3, lines 11-14:

"In addition, the embodiment with the round base, particularly with generally symmetrical, upstanding members at right angles to one another, can be installed readily, and occasional misplacement on the roof is less noticeable."

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The problem addressed is misplacement of snow stops on a roof, i.e., as any person skilled in the art recognizes, misplacement of a snow stop with a square base make its edges have a different angle than its neighbors, which makes for a visibly noticeable mistake. Not only is the outline of the base out of kilter with its neighbors but so are its upstanding members. On the other hand, a round base always makes the same footprint on the roof, and the occasional misplacement leaves only upstanding members not in the same alignment. Mr. Mullane verified this in his Declaration under 37 CFR 1.132 filed on April 21, 2003. The Examiner's attention is directed to page 5, third paragraph:

"Finally, the round-based snow stop of my invention can have several significant advantages. ... [T]he intersecting, upstanding members at a predetermined angle to each other to form a snow restraining member as in [claim] 18, to especially include at normal angles as in [claim] 19, can be most advantageous in the field since installation can be readily accomplished, with the occasional misplacement on the roof less noticeable than with a more square-based snow stop."

Mr. Mullane then verified in his Second 37 CFR 1.132 Declaration, which was filed on October 16, 2003 (page 4, 3rd and 5th paras.):

"Smeja et al. discloses a snow guard. It has a square or triangular base, and triangular snow restraining members. ... [I]t does not add anything to any of the other references to make up for their deficiencies versus my claims. In fact, it teaches away from such things as a round base, ...

"As for such other features as the round base, ... these are not found in any reference, nor, as beneficial as I have discovered them to be in my snow stop, in other commercially available snow guards. I find it difficult to believe that the Examiner would be able to merely deem that a snow stop such as I claim would be obvious with such features."

Smeja et al. teaches that from countless unnamed possibilities for a base form, a square base is named as preferred, and the only other form mentioned for "other shapes" is in the paragraph bridging columns 4-5: a triangle. A square and a triangle, both regular polygons, are fundamentally and plainly different from a circle, which is a curved form. By identifying the shape of a base as a square or triangle, Smeja et al. teaches away from a round base. This is strong evidence of unobviousness. See, In re Hedges, 228 USPQ 685, 687 (Fed. Cir. 1986).

Against the second misstatement above from Paper No. 8, the shape of the base is irrelevant with respect to effectiveness of installation at any orientation. That is a function of symmetry of upstanding members 20, not the base. See, Smeja et al., col. 1, ll. 66-67. No motivation has been shown from the prior art.

Note, too, that no art, to include Smeja et al., which was

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then of record, was applied against claims 18-20 in Paper No. 6. In other words, the rejection of this claimed subject matter, then present as original claims 4-6, over Cline, US 6266929, which had a rectangular base with rounded corners, had been withdrawn over the art of record. Thus, it may be considered that claims 18-20 have been allowed over the art of record, and so, in order to reject these claims with the same art, the standard is very high indeed. See, Grier, 1923 C.D. 27; Hay, 1909 C.D. 18; Nealon, 1897 C.D. 174. The Examiner has not met his burden. Instead, the same failed arguments that had been attempted with respect to Cline, a patent with a snow stop with rounded corners, have been repeated in Paper No. 8.

The Examiner is merely deeming these claims obvious without basis in fact, and also is using the Applicant's own invention disclosure against him as if it were prior art! Both of these things are highly improper, and neither will not do to establish a prima facie case. Note, In re Freed, 165 USPQ 570, 571-572 (CCPA 1970); Jones v. Hardy, 220 USPQ 1021, 1026 (Fed.Cir. 1984).

The rejection of claim 20 under Section 103(a) over Smeja et al. in view of Cline, US 5522185, as set forth in Paper No. 8 is respectfully traversed. The proposed combination does not teach nor suggest the present claim, with its round base and upstanding members with convex, circularly bounded outer boundaries, to an ordinary artisan under the meaning of Section 103(a).

Smeja et al. fails to teach or suggest the round base. Cline adds nothing to Smeja et al. to motivate the ordinary artisan to make a round base, and, in fact, teaches that there should be no base! Since claim 20 depends on claims 18 and 19, it requires a round base as well, and by virtue of this claim 20 distinguishes over the proposed combination. Moreover, Cline teaches that the blades of his snow stop are not circular; they are irregularly shaped. In contrast, claim 20 requires circularity. In addition to these things, misplacement of a snow stop with upstanding members is clearly minimized even further to that which is only provided by a round base when the upstanding members have convex, circularly bounded outer boundaries as required by claim 20.

The reasoning set forth in Paper No. 8 is in serious error.


Please, therefore, withdraw these objections and rejections.

Thus, the application is in condition for allowance. Yet, the Examiner is invited to call the undersigned to discuss the case, or to seek authorization for an Examiner's amendment.

Respectfully submitted,

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